

REMARKS

Claims 1-21 are pending in this application. Claims 1-21 were rejected.

Claim Rejections – 35 U.S.C. § 103

Claims 1-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lovett in view of Wigley et al.

1. Lack of Motivation

An assertion of obviousness in view of multiple references does not support a *prima facie* case of obviousness unless a motivation, suggestion or teaching is identified of the specific combination that was made by the applicants. *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). Each independent claim (claims 1, 10, and 20) recites a “a power supply” having “a remote sense input” within the claim body.

First, the Examiner asserts that a remote sense input is “inherent” because conventional computer power supplies include a remote sense connection including both a positive and negative input, however, the Examiner offered no basis for that assertion as required by the MPEP. MPEP § 2112.IV (“Examiner must provide rationale or evidence tending to show inherency”). Furthermore, no claim recites a computer power supply and the power supply reference upon which the Examiner relies, Wigley, does not mention a remote sense connection or input. Thus, Wigley itself shows that a remote sense input is not inherently present in every power supply.

Second, even if a reference taught a power supply with a remote sense input, both Wigley and Lovett teach away from using their pull-down circuits with a remote sense input of a power supply. Wigley teaches the use of a pull-down circuit to produce an adjustable DC output

voltage having an amplitude not exceeding the amplitude of the drive voltage for application. According to Wigley, that output is especially suitable for driving the anode of a beam penetration CRT. Wigley discloses several reasons why the output of the power supply circuit, including the pull-down circuit, is uniquely configured to drive a CRT. Wigley, Col. 1, Line 13-Col. 2, Line 10. By teaching that the output is specially suited to drive a CRT, Wigley teaches away from the completely different, and never mentioned or suggested, use of that output as an input for a remote sense input. Lovett teaches the use of a pull-down circuit in an invention that “relates to logic circuits, and in particular to logic circuits that may be used to decode address signals in integrated circuits.” Lovett, Col 1, Lines 12-14. Lovett specifies that its circuit is for use in logic circuits and teaches away from the use to which the Examiner, with the hindsight provided by Applicants claimed invention, applies it. Both Lovett and Wigley lack any motivation or suggestion to combine a pull-down circuit with a remote sense input and both actually teach away from that configuration. In the absence of a motivation or suggestion to combine, the obviousness rejection should be withdrawn. MPEP § 2143.01. Prior art cannot be combined in a manner that defeats its purpose. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). Applicants respectfully request withdrawal of the obviousness rejections of claims 1-21 because there is no motivation to combine the references to achieve the specific combination claimed and the references teach away from the asserted combination.

SUMMARY

In light of the above remarks Applicants respectfully submit that the application is now in condition for allowance and early notice of the same is earnestly solicited. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile or electronic mail, as below.


Applicants believe no fees are due. However, should the Commissioner deem any fees are due, including any fees for additional extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and further authorize the Commissioner to debit any additional fees due, or to credit any overpayments, to Baker Botts L.L.P. Deposit Account Number **02-0383**, Order Number **016295.0768**.

Respectfully submitted,

Baker Botts L.L.P.

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